

Applicants : Eric David Harper, *et al.*
Appl. No. : 10/736,038
Examiner : Murali K. Dega.
Docket No. : 20503-4023

REMARKS

Claims 1-25 are pending in the present application.

Claims 1-25 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,189,146 to Misra, *et al.* ("Misra") in view of U.S. Patent No. 7,343,297 to Bergler, *et al.* ("Bergler").

Claims 1, 11, 21, and 23 have been amended within the subject matter of the application as filed.

It is respectfully submitted that no new matter has been added.

Reconsideration of the application as amended herein is respectfully requested.

FINALITY OF REJECTIONS

The Office Action has finally rejected claims 1-25 under 35 U.S.C. §103(a) as being unpatentable over Misra in view of Bergler by stating that Applicant's arguments are moot in view of the new ground(s) of rejection. 01/26/2009, Final Office Action, p. 15, ¶ 56. Applicant notes that Bergler reference was newly cited by the Examiner after the previous response by the Examiner dated October 29, 2008, thus has never been previously considered for the purpose of examining claims 1-25. Therefore, Applicant respectfully requests withdrawal of finality of the Office Action based on the new ground of rejection relying on a newly cited reference, Bergler.

CLAIM REJECTIONS

Rejections under 35 U.S.C. §103(a)

The Office Action has rejected claims 1-25 under 35 U.S.C. §103(a) as being unpatentable over Misra in view of Bergler. Regarding claim 1, the Examiner stated that Misra does not explicitly disclose licenses being returned by the computer to the server, however

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Bergler does teach this feature of claim 1. 01/26/2009, Final Office Action, p. 3, ¶ 5. Applicants respectfully disagree for the following reasons.

As discussed in Applicant's previous response dated October 29, 2008, Misra teaches that once a license is issued to a client, the license is assigned to the client because when the client lost the already-issued license, the server reissues the lost license back to the client. Emphasis added. 10/29/2008, Applicant's response. On the other hand, Bergler teaches that any license previously issued to a client that has been returned by the license clean-up module is subject to being given to a different client. Bergler, col. 12, lines 14-17. This feature of Bergler contradicts Misra because Misra teaches that a license is assigned to a specific client and the license is reissued to the client when lost. Misra, col. 3., lines 3-7; col. 4, lines 54-58. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713, F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). MPEP § 2145 (X)(D)(2). Because Bergler's reissuance of a license to a different client teaches away from the usage of Misra's license, Applicant respectfully submit that the combination of Bergler and Misra to reject claim 1 is improper.

Moreover, Bergler discloses that a license is obtained with an expiration date from a license server and returned to the pool of available licenses on the expiration date of the license. Bergler, abstract; col. 4, lines 28-42.

In contrast, Claim 1, as amended, recites that "the license is voluntarily returnable by the one computer to the server for use by another computer of the plurality of computers." See Original Specification, FIG. 5; ¶ [0045]. Because Bergler's license is set to expire on an expiration date when assigned to a client by the license server, Bergler's license is automatically

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returned (See Bergler, col. 4, lines 28-30), even against the desire of the applicant running the client computer. Bergler requires setting an expiration on a license issued to a client to automatically makes the lost license available again for use by the client. Bergler, col. 4, lines 39-42. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP § 2143.01 (VI). If Bergler's license were made to be "voluntarily returnable" by a client as claim 1 requires, Bergler would fail to operate to make the lost license available again based on an expiration date. Therefore, Bergler cannot be properly combined with Misra to reject claim 1. For these reasons, the combination of Misra and Bergler, individually or in combination, does not teach one or more features of claim 1, thus Applicant respectfully submits that claim 1 and claims 2-10 that depend from claim 1 are not patentable under 35 U.S.C. §102(b) over Misra in view of Bergler.

Claim 11 teaches substantially similar features of claim 1 and recites "the license is voluntarily returnable by the one computer to the server for use by another computer of the plurality of computers." As discussed above, neither Misra nor Bergler does not teach this feature of claim 11, therefore Applicants respectfully submit that claim 11 and claims 12-20 that depend from claim 11 are patentable under 35 U.S.C. §102(b) over Misra in view of Bergler.

Claim 21 teaches substantially similar features of claim 1 and recites "the license is voluntarily returnable by one computer of the plurality of computers to the server for use by another computer of the plurality of computers." As discussed above, neither Misra nor Bergler does not teach this feature of claim 21, therefore Applicants respectfully submit that

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claim 21 and claim 22 that depends from claim 21 are patentable under 35 U.S.C. §102(b) over Misra in view of Bergler.

Claim 23 teaches substantially similar features of claim 1 and recites "the license is voluntarily returnable by the one computer to the server for use by another computer of the plurality of computers." As discussed above, neither Misra nor Bergler does not teach this feature of claim 23, therefore Applicants respectfully submit that claim 23 and claims 24-25 that depend from claim 23 are patentable under 35 U.S.C. §102(b) over Misra in view of Bergler.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending (1) are in proper form, (2) are neither obvious nor anticipated by the relied upon art of record, and (3) are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (650) 614-7400. If there are any additional charges, please charge Deposit Account No. 15-0665.

Respectfully submitted,

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